REMARKS

Claims 1-29 and 51-79 are currently pending in the application. Reconsideration and allowance of the application are respectfully requested.

Applicants kindly acknowledge that the instant Office action includes no rejection based on Publication No. US2002/0186691 to Hoffman. The only rejection is a provisional nonstatutory obviousness type double patenting rejection based on pending App. No. 11/034,675 ("the '675 application"). The Examiner asserts that although the claims of the subject application and the '675 application are not identical, they are not patentably distinct from each other and, therefore, a terminal disclaimer would be required. Applicants respectfully request that the provisional rejection be withdrawn.

Initially, claims 1-100 are not pending in the '675 application as asserted in the Office action. Rather, the Preliminary Amendment submitted with the '675 Application on January 13, 2005 (Attachment A) canceled claims 1-29 and 51-79. See also, Publication No. 2005/0197106, which includes claims 30-50 and 80-100. Further, the Amendment dated February 7, 2005 in the subject '738 application confirms cancellation of claims 30-50 and 80-100 in the subject application. Consequently, **claims 1-29 and 51-79** are pending in the subject '738 application, and **claims 30-50 and 80-100** are pending in the '675 application.

Further, the current provisional rejection and related remarks that the claims are not patentably distinct from each other are contrary to the prior Restriction requirement mailed on December 14, 2004 (Attachment B), which asserts that Application No. 09/837,738 "contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept...[listing groups I and II]" and "the inventions are distinct, from each other because of the following reasons..." (Restriction, pgs. 2 and 3). (Emphasis added).
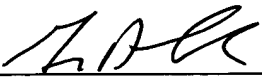
The current Office action also asserts that there is no apparent reason why Applicants would have been prevented from presenting claims in the other copending application. However, the reason there are two separate applications with two sets of claims is that the Examiner requested Applicants to elect one group of claims. In response to the Restriction action, Applicants elected claims 1-29 and 51-79 in the subject application and filed a second / divisional application with claims 30-50 and 80-100 (in the '675 application) (Attachment C).

Accordingly, the provisional obviousness-type double patenting rejection should be withdrawn, and Applicants respectfully request that application is in condition for allowance. If there are any remaining issues that can be resolved by telephone, Applicants invite the Examiner to contact the undersigned at the number indicated below.

Date: July 21, 2006

Respectfully submitted,
BINGHAM MCCUTCHEN, LLP

By:_____

Gary D. Lueck
Registration No.: 50,791

Three Embarcadero Center, Suite 1800
San Francisco, California 94111
Telephone: (213) 680-6400
Telefax: (213) 680-6499

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

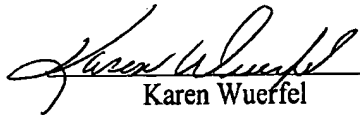|	
In re Application of: Inventors: Steven Bristow, *et al.* Appln. No: Not Yet Assigned 11/034,675 Filed: Herewith Divisional of Appln. No. 09/837,738 Filed April 16, 2001 Title: SOFTWARE AND PROTOCOL STRUCTURE FOR AN AUTOMATED USER NOTIFICATION SYSTEM Divisional Docket No.: 700664-5001	Group Art Unit: Not Yet Assigned Examiner: Not Yet Assigned **CERTIFICATE OF MAILING BY "EXPRESS MAIL"** Express Mail Label No.: ER 972826427 US Date of Deposit: January 13, 2005 I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450. *Karen Wueffel* Karen Wueffel

PRELIMINARY AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Commissioner:

Prior to examination, please amend the above-identified application as follows:

IN THE SPECIFICATION

Please amend the paragraph beginning on page 1, line 6:

CROSS-REFERENCES TO RELATED APPLICATIONS

~~This application claims priority based on provisional patent application Serial No. 60/198,112 filed April 17, 2000, the disclosure of which is incorporated herein by reference for all purposes.~~

This application is a divisional of co-pending U.S. Application No. 09/837,738, filed April 16, 2001, priority which is claimed under 35 U.S.C. §120, which claims priority under 35 U.S.C. §119 to U.S. Provisional Application No. 60/198,112, filed April 17, 2000, the disclosures of which are incorporated herein by reference as if set forth in full.

IN THE CLAIMS

Please cancel claims 1-29 and 51-79 without prejudice. Pending claims 30-50 and 80-100 follow.

1.   (Canceled).

2.   (Canceled).

3.   (Canceled).

4.   (Canceled).

5.   (Canceled).

6.   (Canceled).

7.   (Canceled).

8.   (Canceled).

9.   (Canceled).

10.   (Canceled).

11.   (Canceled).

12.   (Canceled).

13.   (Canceled).

14.   (Canceled).

15.   (Canceled).

16.   (Canceled).

17.   (Canceled).

18. (Canceled).

19. (Canceled).

20. (Canceled).

21. (Canceled).

22. (Canceled).

23. (Canceled).

24. (Canceled).

25. (Canceled).

26. (Canceled).

27. (Canceled).

28. (Canceled).

29. (Canceled).

30. (Original) A method of notifying a user of an occurrence of an event associated with a user item, the method comprising the steps of:

receiving a set of notification instructions;

automatically detecting the occurrence of the event;

encoding a data packet with event data, the data packet comprising a plurality of content fields, wherein at least one content field comprises a plurality of event data types;

transmitting the data packet over a communication link to an automated network operations center;

receiving the data packet at the automated network operations center;

decoding the data packet;

making an automatic determination, based in part upon the decoded event data and upon the set of notification instructions, whether the user should be notified of the event; and

automatically notifying the user of the event if the determination is that the user should be notified.

31. (Original) The method of claim 30, wherein the event corresponds to a condition of the user item.

32. (Original) The method of claim 30, wherein the detecting step further comprises the step of polling the user item.

33. (Original) The method of claim 30, wherein the detecting step is responsive to a request.

34. (Original) The method of claim 30, wherein the set of notification instructions is input to the automated network operations center.

35. (Original) The method of claim 30, wherein the set of notification instructions comprises a notification sequence.

36. (Original) The method of claim 30, wherein the set of notification instructions comprises the selection of at least one of a plurality of notification devices.

37. (Original) The method of claim 30, wherein the detecting step comprises the step of receiving user item location information from a GPS receiver.

38. (Original) The method of claim 30, wherein the automatic notification step further comprises the step of providing a user item location.

39. (Original) The method of claim 30, further comprising a step of automatically performing an action upon the user item in response to the occurrence of the event, wherein the step of automatically performing the action is controlled by the automated network operations center.

40. (Original) The method of claim 30, further comprising a step of receiving a user item control command.

41. (Original) The method of claim 30, wherein the content field which comprises a plurality of event data types occupies approximately one byte of the data packet.

42. (Original) The method of claim 30, wherein the content field which comprises a plurality of event data types occupies two digits of the data packet.

43. (Original) The method of claim 31, wherein the user item is selected from the group consisting of vehicles, residential property, commercial property, and personal items.

44. (Original) The method of claim 34, wherein the inputting step is performed via a public information network.

45. (Original) The method of claim 34, wherein the inputting step is performed via a telephone.

46. (Original) The method of claim 34, wherein the inputting step is performed via a keypad corresponding to the telephone.

47. (Original) The method of claim 34, wherein the inputting step is performed via a telephone utilizing voice input and wherein the automated network operations center comprises a voice recognition system.

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48.   (Original) The method of claim 36, wherein the plurality of notification devices is selected from the group consisting of facsimile machines, telephones, pagers, electronic mail, and a public information network interface.

49.   (Original) The method of claim 40, further comprising a step of controlling the user item according to the user item control command.

50.   (Original) The method of claim 42, wherein the public information network is the Internet.

51.   (Canceled).

52.   (Canceled).

53.   (Canceled).

54.   (Canceled).

55.   (Canceled).

56.   (Canceled).

57.   (Canceled).

58.   (Canceled).

59.   (Canceled).

60.   (Canceled).

61.   (Canceled).

62.   (Canceled).

63.   (Canceled).

64.   (Canceled).

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65. (Canceled).

66. (Canceled).

67. (Canceled).

68. (Canceled).

69. (Canceled).

70. (Canceled).

71. (Canceled).

72. (Canceled).

73. (Canceled).

74. (Canceled).

75. (Canceled).

76. (Canceled).

77. (Canceled).

78. (Canceled).

79. (Canceled).

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80.   (Original) An apparatus of notifying a user of an occurrence of an event associated with a user item, the apparatus comprising:

means for receiving a set of notification instructions;

means for automatically detecting the occurrence of the event;

means for encoding a data packet with event data, the data packet comprising a plurality of content fields, wherein at least one content field comprises a plurality of event data types;

means for transmitting the data packet over a communication link to an automated network operations center;

means for receiving the data packet at the automated network operations center;

means for decoding the data packet;

means for making an automatic determination, based in part upon the decoded event data and upon the set of notification instructions, whether the user should be notified of the event; and

means for automatically notifying the user of the event if the determination is that the user should be notified.

81.   (Original) The apparatus of claim 80, wherein the event corresponds to a condition of the user item.

82.   (Original) The apparatus of claim 80, wherein the detecting means comprises means for polling the user item.

83.   (Original) The apparatus of claim 80, wherein the detecting means is responsive to a request for detection.

84.   (Original) The apparatus of claim 80, wherein the receiving means comprises means for receiving a set of notification instructions input to the automated network operations center.

85.   (Original) The apparatus of claim 80, wherein the set of notification instructions comprises a notification sequence.

86.   (Original) The apparatus of claim 80, wherein the set of notification instructions comprises the selection of at least one of a plurality of notification devices.

87.   (Original) The apparatus of claim 80, wherein the detecting means comprises means for receiving user item location information from a GPS receiver.

88.   (Original) The apparatus of claim 80, wherein the automatic notification means comprises means for providing a user item location.

89.   (Original) The apparatus of claim 83, further comprising means for automatically performing an action upon the user item in response to the occurrence of the event, wherein the step of automatically performing the action is controlled by the automated network operations center.

90.   (Original) The apparatus of claim 80, wherein the receiving means comprises means for receiving a user item control command.

91.   (Original) The apparatus of claim 80, wherein the content field which comprises a plurality of event data types occupies approximately one byte of the data packet.

92.   (Original) The apparatus of claim 80, wherein the content field which comprises a plurality of event data types occupies two digits of the data packet.

93.   (Original) The apparatus of claim 81, wherein the user item is selected from the group consisting of vehicles, residential property, commercial property, and personal items.

94.   (Original) The apparatus of claim 84, wherein the notification instructions are input via a public information network.

95.   (Original) The apparatus of claim 84, wherein the notification instructions are input via a telephone.

96.   (Original) The apparatus of claim 84, wherein the notification instructions are input via a keypad corresponding to the telephone.

97.   (Original) The apparatus of claim 84, wherein the notification instructions are input via a telephone utilizing voice input and wherein the automated network operations center comprises a voice recognition system.

98.   (Original) The apparatus of claim 86, wherein the plurality of notification devices is selected from the group consisting of facsimile machines, telephones, pagers, electronic mail, and a public information network interface.

99.   (Original) The apparatus of claim 90, further comprising means for controlling the user item according to the user item control command.

100.   (Original) The apparatus of claim 92, wherein the public information network is the Internet.

In co-pending Application No. 09/837,738, Applicants elected Group I - claims 1-29 and 51-79. The claims of Group II - claims 30-50 and 80-100 - are included in the subject divisional application.

DATE: January 13, 2005

Respectfully submitted,

BINGHAM McCUTCHEN, LLP

By: _____
Gary D. Lueck
Registration No. 50,791
Antoinette Konski
Registration No. 34,202
Attorneys for Applicants

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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,738	04/16/2001	Steven Bristow	22962-7005	9746

7590   12/14/2004

McCutchen, Doyle
Brown & Enersen, LLP
28th Floor
Three Embarcadero Center
San Francisco, CA 94111

EXAMINER
MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
2686	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims.

4)☒ Claim(s) _1-100_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) _1-100_ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _6/7_

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Information Disclosure Statement

1.   The information disclosure statement filed reference listed in the information Disclosure

submitted on 10/4/04, 09/24/04 have been considered by the examiner (see attached PTO-1449

ι

Election/Restriction

2.   Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not

so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a

single invention to which the claims must be restricted.

> I.   Claims 1-29, 51-79, drawn to method/apparatus of providing status data regarding
>
> a user item, comprising: obtaining and encoding first type of status data, a second
>
> type of status data and third type of status data and transmitting the data,
>
> classified in class 704, subclasses 212.
>
> II.   Claims 30-50, 80-100, drawn to method/an apparatus of notifying a user of an
>
> occurrence of an event associated with a user item, comprising receiving a set of
>
> notification instructions; automatically detecting the occurrence of the event;
>
> encoding a data packet with event data, the data packet comprising a plurality of

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content fields, wherein at least one content field comprises a plurality of event

data types; transmitting the data packet over a communication link to an

automated network operations center; receiving the data packet at the automated

network operations center; decoding the data packet; making an automatic

determination, based in part upon the decoded event data and upon the set of

notification instruction, whether the use should be notified of the event; and

automatically notifying the user of the event if the determination is that the user

should be notified classified in class 340, subclasses 573.1, 426, 5.72, 539, 427,

428, 573.1, 537.4, and classified 455, subclasses 405, 410, 457.

The claims are deemed to correspond to the species listed above in the following manner:

3.   The inventions are distinct, each from the other because of the following reasons:

Inventions in this relationship are related as combination and subcombination. Inventions

in this relationship are distinct if it can be shown that (1) the combination as claimed does not

require the particulars of the subcombination as claimed for patentability, and (2) that the

subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant

case, the combination as claimed does not require the particulars of the subcombination as

claimed because Group I is method/apparatus of providing status data comprising: obtaining and

encoding of encoding a data packet, classified in class 704, subclass 202, and Group II is a of

notifying a user automatically detecting the occurrence of event, classified in class 340,

subclasses 573.1, 426, 5.73, 539, 427, 428, 573.1, 537.4. The subcombination has separate

utility such a notification of user automatically and detecting the occurrence of data.

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4.   Because these inventions are distinct for the reasons given above and the search required

for Group I is different than Group II restriction for examination purposes as indicated is proper.

5.   A telephone call was made to Roger Sampson with registration number of 44314 on

12/02/04 to request an oral election to the above restriction requirement, but did not result in an

election being made.

6.   Applicant is advised that the reply to this requirement to be complete must include an

election of the invention to be examined even though the requirement be traversed (37 CFR

1.143).

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Naghmeh Mehrpour whose telephone number is 703-308-7159.

The examiner can normally be reached on 8:00- 6:00.

       If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Marsha Banks-Harold be reached (703) 305-4379.

       The fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

       Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

November 29, 2004

Docket No.: 700664-2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Group Art Unit: 2686
Inventors: Steven Bristow, *et al.*	Examiner: Naghmeh Mehrpour
Appln. No.: 09/837,738	**Certificate of Mailing Under** **37 C.F.R. § 1.8**
Filed: April 16, 2001	Date of Deposit: January 7, 2005

Title: SOFTWARE AND PROTOCOL STRUCTURE FOR AN AUTOMATED USER NOTIFICATION SYSTEM

Pursuant to 37 C.F.R. § 1.8, I hereby certify that this correspondence and all attachments are being deposited with the United States Postal Service as first class mail on the date indicated above in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Karen Wuerfel

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Restriction Election Requirement mailed December 14, 2004, Applicants hereby elect, without traverse, the claims of Group I – claims 1-29 and 51-79. Applicants reserve their right to file one or more divisional applications with the claims of Group II - claims 30-50 and 80-100.

Any questions regarding the above election should be brought to undersigned's attention.

DATE: January 7, 2005   Respectfully submitted,

BINGHAM McCUTCHEN, LLP

By: _____

Gary D. Lueck
Registration No. 50,791
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Attorneys for Applicants

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